

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVE B. TAYLOR

Appeal 2007-1594
Application 10/600,379
Technology Center 3600

Decided: June 22, 2007

Before WILLIAM F. PATE, III, TERRY J. OWENS, and STUART S. LEVY,
Administrative Patent Judges.

PATE, III, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-22. These are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 134.

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The claimed invention is directed to a joint that finds special utility in connecting a wakeboard tower to a boat hull. Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A variably positionable coupler mountable on a curved surface, comprising:

 a base formed with an upper side and a lower side,
 wherein the lower side is a substantially flat planar surface;
 means for mounting the base on the curved surface;
 a tub adjustably connectable to the base;
 a plug repositionably attachable to the tub;
 a neck rotatably insertable in the plug,
 wherein the neck is formed for securing a shaft to the neck; and
 a clevis mechanism slidably and demountably engageable with the plug and
 the neck.

The references of record relied upon by the Examiner as evidence of anticipation and obviousness are:

Schroeder	1,257,536	Feb. 26, 1918
Murray	5,697,320	Dec. 16, 1997
Landgrebe	5,704,749	Jan. 6, 1998

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Claim 11 stands rejected under 35 U.S.C. § 112, first paragraph, as directed to a disclosure that would not have enabled one of ordinary skill to make and use the claimed invention.

Claims 1-3 stand rejected under 35 U.S.C. § 102 as anticipated by Murray.

Claim 4 stands rejected under 35 U.S.C. § 103 as unpatentable over Murray in view of Landgrebe.

Claim 5 stands rejected under 35 U.S.C. § 103 as unpatentable over Murray in view of Landgrebe and Schroeder.

Claims 6-13 and 16-22 stand rejected under 35 U.S.C. § 103 as unpatentable over Murray in view of Schroeder.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Murray in view of Schroeder and further in view of Landgrebe.

ISSUES

The two issues for our consideration are the § 112, first paragraph, rejection of claim 11 and the rejections based on prior art of claims 1-22.

FINDINGS OF FACT

Murray discloses a variably positionable coupler for mounting on a boat hull. Murray has a base with an upper and lower side, with the lower side being a substantial flat planar surface. A first coupling with an eyelet fitting 46 is pivotally mounted on the base. The Examiner regards this mounting as a tub, inasmuch as the eyelet allows pivoting around pin 41, and the other end of the fitting receives

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tubular member 42. The Examiner regards tubular member 42 and the associated coupling 71 as the plug. The Examiner regards member 55 which is pivotally connected to member 71 by a pin, which could be regarded as a clevis, as the neck portion. It is our finding that the plug, as enumerated by the Examiner, is not repositionably attached to the tub, and that the base portion is not attached to a curved surface. Therefore, we do not find that claims 1-3 are anticipated by Murray.

Landgrebe shows a self-aligning fastener system. The system relies on frustoconical recesses 35, 55 formed adjacent the proximal end of one or more bores. These recesses are beneficial in improving the alignment of a fastener within its bore during assembly. See col.4, ll. 1-20.

Schroeder discloses a mounting arrangement for a stanchion placed upon a moving vehicle such as an automobile. Schroeder discloses a hemispherical seat 8 or ball washer that cooperates with a hemispherical recess on the base of the stanchion so that the coupling may be variably positioned to a vertical position or a variable inclination according to the desired orientation of the stanchion.

PRINCIPLES OF LAW

The prior art may anticipate a claimed invention, and thereby render it non-novel, either expressly or inherently. *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002), cert. denied, 538 U.S. 907 (2003). Express anticipation occurs when the prior art expressly discloses each limitation (i.e., each element) of a claim. *Id.* In addition, [i]t is well settled that a

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prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. *Id.*

“Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Court set out a framework for applying the statutory language of §103, language itself based on the logic of the earlier decision in *Hotchkiss v. Greenwood*, 11 How. 248 (1851), and its progeny. See 383 U.S., at 15-17. The analysis is objective:

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Id.*, at 17-18.

While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under §103.” *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

The enablement provision of the Patent Act requires that the patentee provide a written description of the invention “in such full, clear, concise, and

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exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.” 35 U.S.C. § 112, first paragraph (2000). The purpose of this requirement is to ensure that “the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims.” *Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1195-96 (Fed. Cir. 1999); see also Donald S. Chisum, 3 Chisum on Patents § 7.01 (2002). “Accordingly, we have held that the specification must provide sufficient teaching such that one skilled in the art could make and use the full scope of the invention without undue experimentation.” *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1338 (Fed. Cir. 2003); *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997); *In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). “The key word is ‘undue,’ not experimentation.” *Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (citation omitted). That is, the specification need only teach those aspects of the invention that one skilled in the art could not figure out without undue experimentation. *Id.*

ANALYSIS

Turning first to the rejection of claim 11 under 35 U.S.C. § 112, first paragraph, it is the Examiner’s contention that claim 11 is based on a disclosure that would not have enabled one of ordinary skill to make or use the invention without undue experimentation. For such a rejection to be sustained, it is incumbent upon the Examiner to show that one of ordinary skill could not make the invention without such undue experimentation. The Examiner has not raised

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the issue of undue experimentation. The Examiner does not mention any of the so-called *Wands* factors. We cannot sustain a rejection based on § 112, first paragraph, for lack of enablement, based on such cursory treatment.

As noted above in our findings of fact, we do not sustain the rejection of claims 1-3 as lacking novelty over the Murray reference for two reasons. In the first place, it is unclear from the Murray reference that the component 42 and 77 that the Examiner has labeled the plug is indeed repositionable with respect to the tub. Indeed, Figure 2 of Murray appears to show eyelet fitting 46 still attached to component 42 while submerged in sand. Secondly, we give the preambular limitation of mountable to a curved surface weight in this claim, inasmuch as the curved surface is mentioned in the body of the claim with respect to the base. We believe that the Examiner's argument that the hull of Murray is curved in some other location remote from the mounting is unreasonable and thus beyond the broadest reasonable interpretation of the claimed subject matter. We do not sustain the § 103 rejections of the dependent claims 4-10 for the same reasons.

On the other hand, with respect to claims 11-19, we will affirm the rejections of these claims under § 103. Murray shows a base formed with opposing yokes and a boom swivel device fixable to the base for securing the shaft to the coupling system. Schroeder teaches a joint which uses a ball washer and a hemispherical seat in mounting a structure at different angles to the mounting surface. In our view it would have been obvious to provide the multiple mounting bolts of Murray

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with the ball washer attachments of Schroeder so that the mounting plate in Murray could be mounted on an uneven, tilted or curved surface.

Furthermore, with respect to claims 14 and 15 we are in agreement with the Examiner that it would have been obvious to use the self-aligning recesses disclosed by Landgrebe for their disclosed purpose when securing the coupler system to an uneven, tilted or curved surface using the ball washers disclosed in Schroeder. We believe these modifications, taught by Schoeder and Landgrebe, to be merely the rearrangement of old elements in a predictable manner likely to have been obvious to one of ordinary skill. *See KSR*, at 127 S.Ct at 1740, 84 USPQ2d at 1396.

We have carefully reviewed the arguments of the Appellant. We note that Appellant argues that variably positionable actually means universally adjustable. We do not agree. We regard this gloss of the claim terminology as an attempt to read limitations from the Specification into the claims where they do not actually appear. We are in agreement with the Examiner that Murray discloses a variably positionable coupler structure.

REJECTION UNDER 37 C.F.R. § 41.50(b)

All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious--the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Our analysis of the claims indicates that considerable speculation as to meaning of the terms employed and assumptions as to the scope of such claims needs to be made. A rejection under 35 U.S.C. 103 should not be based on such speculations and assumptions. *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962); *Ex parte Head*, 214 USPQ 551 (BdPatApp&Int 1981). Accordingly, we reverse the 35 U.S.C. § 103 rejection of claims 20-22 and enter the rejection noted hereinbelow. It must be noted, however, that this is a technical reversal, based on the indefiniteness of the subject matter, and is not to be construed as a reversal based on the prior art cited by the examiner. The art rejection of claims 20-22 is reversed and a rejection under 35 U.S.C. § 112, second paragraph, is hereby entered. Claims 20-22 includes elements, notably the tub, the plug, and the plug and the neck, respectively, which lack antecedent basis. This renders the claims indefinite.

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CONCLUSION OF LAW

The Examiner has not established that claims 1-3 lack novelty over Murray. Likewise, the Examiner has not established that claims 4-10 are prima facie obvious. On the other hand, the Examiner has established the prima facie obviousness in claims 11-19. The § 112 rejection of claim 11 has been reversed.

A reversal and a new rejection of claims 20-22 pursuant to 37 C.F.R. § 41.50(b) under 35 U.S.C. § 112, second paragraph, has been entered by the Board.

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Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmation is deferred until conclusion of the prosecution before the Examiner

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unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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